

REMARKS

The Applicants mailed a Notice of Appeal on January 5, 2006 which was received by the Office on January 9, 2006 in response to an Office Action mailed October 11, 2005. The Applicants now file herewith a Request For Continued Examination along with the appropriate Petition For Extension of Time withdrawing the appeal and reopening prosecution pursuant to MPEP § 1215.01. The Applicants thank the Examiner for indicating the allowability of claims 6, 13, 14, 16, and 22 if rewritten in independent form.

Claims 1-31 have been amended to insert traditional Markush group language or to correct minor grammatical errors. Claim 34 has been amended to depend on claim 1. Claims 32 and 35-39 have been withdrawn by the Examiner as non-elected.

The amendments are fully supported by the original claims and the specification and do not contain new matter. The Applicants expressly rebut any presumption that the Applicants have surrendered any equivalents under the doctrine of equivalents and expressly state that the claims, as amended, are intended to include and encompass the full scope of any equivalents as if the claims had been originally filed and not amended.

I. Obviousness-Type Double Patenting Rejection

Claims 1-5, 7-12, 15, 17-21, 23-31, 33 and 34 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10, 16, and 33 of copending Application No. 10/743,642. The Applicants respectfully request that the Examiner hold this rejection in abeyance until the claims of the present application are otherwise deemed allowable at which time the Applicants will consider filing a terminal disclaimer.

II. Claim Rejections Under 35 USC § 103

Claims 1, 2, 12, 23, 24, 33 and 34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,342,851 ("Sanfilippo"). According to the Examiner, Sanfilippo teaches pyrrolyl-thiazole compounds that are structurally similar to the claimed compounds. The Examiner cites formula III in Sanfilippo wherein R is hydrogen, R₃ is hydrogen, A is carboxamido, B is alkyl, and Q is alkoxy, and the Examiner also cites Example 233 in column 34. The Applicants respectfully traverse this rejection for the following reasons.

A. The Law of Obviousness Under 35 U.S.C. § 103

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the **differences** between the subject matter sought to be patented and the prior art are such that the subject matter **as a whole** would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains" (emphasis added). 35 U.S.C. § 103(a).

Under 35 U.S.C. § 103, "the scope and content of the prior art are to be determined; **differences between the prior art and the claims at issue are to be ascertained**; and the level of ordinary skill in the pertinent art resolved." *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459, 467 (1966) (emphasis added). The following tenets of patent law must be considered and adhered to when applying 35 U.S.C. § 103:

- (A) The claimed invention must be considered **as a whole**;
- (B) The references must be considered **as a whole** and **must suggest the desirability** and thus the obviousness of making the combination; and

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

For claims directed to chemical compounds, "obviousness requires 'structural similarity between claimed and prior art subject matter . . . **[but only] where the prior art gives reason or motivation to make the claimed compositions.**'" *Yamanouchi Pharmaceutical Co., Ltd. et al. v. Danbury Pharmacal, Inc. et al.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) (emphasis added).

"The fact that **a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.**" *In re Baird* 16 F.3d 380, 382 (Fed. Cir. 1994) ("While the Knapp formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the disclosure of Knapp suggesting that one should select such variables.") (emphasis added). "[H]omology should not be automatically equated with prima facie obviousness." *In re Langer*, 59 C.C.P.A. 1256, 1260, 465 F.2d 896, 899 (CCPA 1972) (Claims to a polymerization process using a sterically hindered amine were held unobvious over a similar prior art process because the prior art disclosed a large number of unhindered amines and only one sterically hindered amine (**which differed from a claimed amine by 3 carbon atoms**), and therefore the reference **as a whole** did not apprise the ordinary artisan of the significance of hindered amines **as a class**). *See also In re Jones*, 958 F.2d 347, 350 (Fed. Cir. 1992) (reversing obviousness rejection of novel dicamba salt with acyclic structure over broad prior art genus encompassing claimed salt, where disclosed examples of genus were dissimilar in structure, lacking an ether linkage or being cyclic); and *Ex parte Burtner and Brown*, 121 U.S.P.Q. 345, 347 (Bd. of App. 1951) (holding claimed alcohols patentable over prior art compounds differing by a -CH₂- group). In the *In re Langer* case, the court held that:

We view appellants' invention "**as a whole**" as being the use of sterically hindered amines as opposed to unhindered amines in a known process to solve

a particular problem We do not think the [prior art] patent provides a basis for the use of sterically hindered amines as a class, or of any of the amines encompassed by appellants' claims The presence in the reference of an isolated hindered amine . . . does not, by itself, apprise the ordinary artisan of the significance of hindered amines as a class when "all of the disclosures in a reference" are considered, the overall suggestion to emerge from the prior art reference may be contrary to that which might appear from an isolated portion of the reference. *In re Langer*, 465 F.2d at 899 (emphasis added).

Similarly, the court in the *In re Baird* case held that while a prior art genus unquestionably encompasses the claimed invention when certain variables are chosen, there is nothing in the disclosure of the prior art reference to suggest that one should select such variables:

While the Knapp formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the disclosure of Knapp suggesting that one should select such variables.

* * * *

Given the vast number of diphenols encompassed by the generic diphenol formula in Knapp and the fact that the diphenols that Knapp specifically discloses to be 'typical,' 'preferred,' and 'optimum,' are different from and more complex than bisphenol A, we conclude that Knapp does not teach or fairly suggest the selection of bisphenol A. *In re Baird* 16 F.3d at 383 (emphasis added)

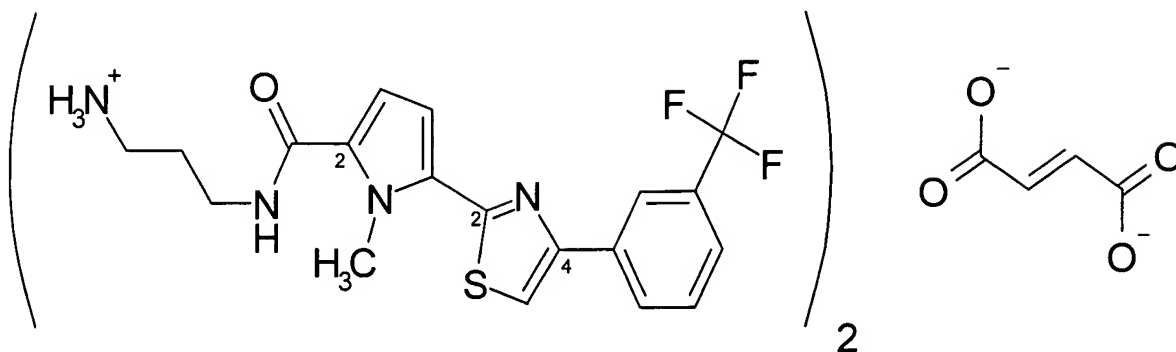
B. The Claims Are Not Obvious

Here, in the present application, the Examiner is making an obviousness rejection on the same basis as the Examiners in the *Baird* and *Langer* applications made which was held to be improper and was reversed by the U.S. Court of Appeals, Federal Circuit and the U.S. Court of Customs and Patent Appeals, respectively. Like the *In re Baird* and *In re Langer* cases, the prior art reference discloses only an isolated possibility of a compound (from a broad genus) that the Examiner states is structurally similar to the compounds of the claimed invention.

It is respectfully submitted that in attempting to show obviousness, the Examiner (using impermissible hindsight) had to actively seek out and select formula III (from formulas I, II, and III in Sanfilippo) and then had to actively seek out and select various substituents from formula III to arrive at a pyrrolyl compound in Sanfilippo that the Examiner states is structurally similar to a pyrrolyl compound covered by the Applicants' claimed invention. Sanfilippo, only discloses 7 examples (out of 237) that relate to pyrrolyl compounds (examples 231-237). All of these examples fall outside the genus of the claimed invention and are different from any genus, sub-genus, or species disclosed or claimed in Applicant's application.

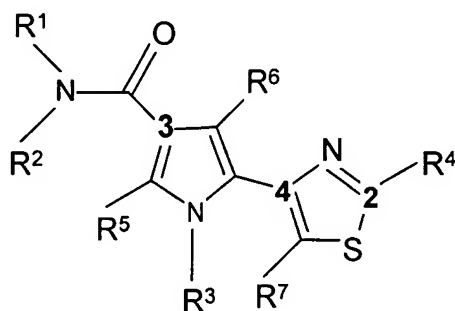
1. The Scope And Content Of The Prior Art & The Difference Between The Prior Art And The Claims At Issue

The Examiner only identifies a single example (example 233, column 34 of Sanfilippo) out of 208 examples disclosed in Sanfilippo that the Examiner states is structurally similar to the claimed invention. However, example 233, column 34 of Sanfilippo, is not a homolog, isomer, or otherwise structurally similar to any of the compounds in any of the Applicant's claims. This is because Example 233, column 34 of Sanfilippo requires that the pyrrolyl group be attached at the 2-position directly between the nitrogen and sulfur of the thiazole ring and also requires that the trifluoromethyl phenyl be attached at the 4-position on the thiazole ring as shown below:



2-[2-(3-Aminopropylcarbamoyl)-1-methyl-1H-pyrrol-5-yl]-4-(3-trifluoromethyl phenyl)-1,3-thiazole hemisfumarate (Example 233, column 34 of Sanfilippo).

In contrast, the pyrrolyl group of the present invention is always attached to the 4-position on the thiazole (not the 2-position). Also the R₄ substituent of the present invention is always attached to the 2-position of the thiazole (not the 4-position as in Sanfilippo):



Formula I Of The Present Invention

In fact, all the compounds of formula III in Sanfilippo have a substituent attached to the 4-position on the thiazole ring which does not exist on the thiazole ring of the present invention (since the pyrrolyl group of the present invention must be attached to

the 4-position). Thus, the thiazole group of the present invention has a completely different substitution pattern than the thiazole group disclosed in Sanfilippo.

The pyrrolyl group of formula 1 of the present invention is also different than the pyrrolyl group of Sanfilippo because the pyrrolyl group of formula 1 of the present invention is always substituted at the 3-position by an amide group (R^1R^2NCO) (see structure above) whereas the compounds of Sanfilippo are always substituted at the 2-position (and often not by an amide). Thus, similar to the thiazole group, the pyrrolyl group of the present invention has a completely different substitution pattern than the pyrrolyl group disclosed in Sanfilippo.

Accordingly, no compound in Sanfilippo is a homolog, isomer, or otherwise structurally similar to any compound claimed by the present invention.

Furthermore, the claimed invention of the present application only relates to pyrrolyl compounds. In contrast, 97% of the examples in Sanfilippo are not pyrrolyl compounds ($230/237 = 97\%$). Again, 230 compounds out of 237 relate either to pyrazole or phenyl compounds (not pyrrolyl compounds). Moreover, as stated above, the 7 compounds out of 237 in Sanfilippo that are pyrrolyl compounds fall outside the genus of the claimed invention and are not homologs, isomers, or otherwise structurally similar to any compound claimed by the present invention.

Furthermore, the R, R1, R2, R3, and A-(B)-Q substituents of formula III in Sanfilippo either don't exist, are much different, and/or are much broader than the corresponding substituents of formula I of the claimed invention. For example, the R3 substituent on the thiazole ring of formula III in Sanfilippo is different and extremely broad compared to the R7 substituent on the thiazole ring of the presently claimed invention. Similarly, the R1 substituent on the pyrrolyl ring of formula III in Sanfilippo is different and much broader compared to the R5 or R6 substituents on the pyrrolyl ring of the claimed invention.

Like the *In re Baird* case, there is no suggestion or motivation to select a compound close in structure to the claimed invention (or to seek out and select a particular genus and various substituents within that genus to arrive at a pyrrolyl compound that would be structurally similar to the claimed invention) and to further modify such a compound to arrive at the claimed invention. As in the *In re Langer* case, Sanfilippo fails to "apprise the ordinary artisan of the significance of the [Applicants' compounds] as a class." *In re Langer*, 465 F.2d at 899. In addition, there is no structural similarity between any compound disclosed in Sanfilippo and any compound claimed by the Applicants (as shown above).

2. The Reference And The Claimed Invention Must Be Viewed As A Whole

The Examiner appears to give little weight to the differences enumerated above between the claimed invention and the vast majority (97%) of the other non-pyrrolyl compounds disclosed Sanfilippo (noting that "consideration is not limited to the preferred embodiments or working examples"). See the final Office Action on page 12.

However, the Courts have ruled that prior art references must be considered **as a whole and without the benefit of impermissible hindsight** vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986). The preferred embodiments and working examples (including the non-pyrrolyl compounds) are critical in viewing the reference as a whole. Again see *In re Baird*, 16 F.3d at 383, where the Court held that since the typical, preferred, or optimum compounds of a prior art reference are different from the claimed invention, the claimed invention is not obvious because the reference does not fairly teach or suggest the claimed invention.

Here, it is respectfully submitted that the Examiner does not consider Sanfilippo as a whole. When Sanfilippo is viewed as a whole, it appears that the Examiner has

used impermissible hindsight and simply created or picked out a compound from the genus of Sanfilippo's Formula III and a single example out of 237 examples disclosed in Sanfilippo [which is not even structurally similar for the reasons stated above]) to arrive at a compound that the Examiner states is structurally similar to a compound covered by the claimed invention.

The Applicants again respectfully submit that the Examiner seems to be using impermissible hindsight vision afforded by the claimed invention to seek out and select a specific example or various substituents from formula III in order to identify or create a compound from a broad genus that the Examiner states is structurally similar to a compound covered by the Applicants claimed invention.

Regardless of example 233 or the specific substituents selected by the Examiner in formula III, **when viewed as a whole**, all the other compounds disclosed in Sanfilippo (which were not cited by the Examiner) are clearly not structurally similar to any compound covered by the claimed invention. Accordingly, as in the *In re Baird* and *In re Langer* cases, without more (showing the significance of or distinguishing example 233 or the specific variables selected by the Examiner from the other compounds and variables), there is no motivation to select a compound close in structure to the claimed invention and then modify it to arrive at the claimed invention.

3. There Is No Motivation To A Person Of Ordinary Skill In The Art

"[T]here is nothing in the disclosure of [Sanfilippo] suggesting that one should select such variables." *In re Baird*, 16 F.3d at 383. As in the *In re Langer* case, there can be no motivation to one of ordinary skill in the art to select an isolated possibility of a structurally similar compound absent a showing that Sanfilippo distinguishes such **isolated** possibilities of structurally similar compounds **as a class** from the plethora of compounds that are not structurally similar- which it fails to do. Moreover, as stated previously, this isolated possibility that the Examiner argues is structurally similar (either

example 233 or through the selection of specific variables in formula III) is not in fact structurally similar to any compound covered by the claimed invention (as shown in the above structural diagrams). Even if there was motivation to select Example 233 or to select specific substituents in formula III, some additional motivation, suggestion or significance would be necessary for a person of ordinary skill in the art to change the substitution pattern on the thiazole group as well as the pyrrolyl group of Sanfilippo to match the specific substitution pattern of the claimed invention (without using the claimed invention as a reference – which would be using impermissible hindsight). That additional motivation clearly does not exist.

C. Conclusion

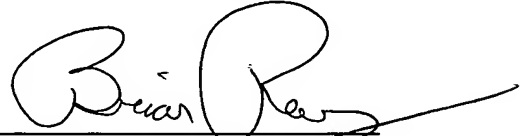
In sum: (1) there is no structural similarity between any compound disclosed in Sanfilippo and the claimed invention for the reasons stated previously (and as shown above in the structural diagrams); and (2) even if the compounds identified by the Examiner in Sanfilippo could be considered structurally similar, no motivation exists to select such compounds and then modify them to arrive at the claimed invention for the reasons stated above. Accordingly, the Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

Because the *In re Baird* case is important to the Applicants' arguments, the Applicants attach a copy herewith as Exhibit A for the Examiner's convenience.

Application No.: 10/743,403
Filed: December 22, 2003

Entry of the foregoing remarks and amendments is respectfully requested. No additional fees are believed to be due in connection with the filing of this Amendment. However, if any additional fee is deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian Remy", with a long horizontal line extending from the end of the signature.

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EXHIBIT A

In re Brian W. BAIRD, Art F. Diaz,
William H. Dickstein and
Charles M. Seymour.

No. 93-1262.

United States Court of Appeals,
Federal Circuit.

Jan. 19, 1994.

Examiner's final rejection of claims of patent application, entitled "Flash Fusible Toner Resins," as unpatentable on ground of obviousness was affirmed by the Board of Patent Appeals and Interferences. Applicants appealed. The Court of Appeals, Lourie, Circuit Judge, held that: (1) fact that many diphenols specifically enumerated in prior reference were derivatives of bisphenol A did not establish that reference suggested selection of bisphenol A itself in preparation of flash fusible toner, and (2) given vast numbers of diphenols encompassed by generic diphenol formula in reference, and fact that diphenols that reference specifically disclosed to be typical, preferred, and optimum were different from and more complex than bisphenol A, reference did not teach or fairly suggest selection of bisphenol A in preparation of flash fusible toner.

Reversed.

1. Patents \Rightarrow 324.5, 324.55(2)

Federal Circuit Court of Appeals reviews obviousness determination by Board of Patent Appeals and Interferences de novo, while it reviews underlying factual findings for clear error.

2. Patents \Rightarrow 16.25

Prior reference did not provide requisite motivation for selection of bisphenol A in preparation of flash fusible toner comprising polyester of bisphenol A and aliphatic dicarboxylic acid, and thus, reference did not teach or fairly suggest selection of bisphenol A in preparation of toner resin so as to render claim 1 of patent application unpatentable on ground of obviousness, even though generic diphenol formula of reference encompassed bisphenol A and reference spe-

cifically disclosed three dicarboxylic acids recited in claim, given vast number of diphenols encompassed by generic diphenol formula in reference and fact that diphenols that reference specifically disclosed to be typical, preferred, and optimum were different from and more complex than bisphenol A. 35 U.S.C.A. § 103.

3. Patents \Rightarrow 314(5)

What reference teaches is question of fact.

4. Patents \Rightarrow 16.25

Fact that claimed compound may be encompassed by disclosed generic formula does not by itself render compound obvious and unpatentable. 35 U.S.C.A. § 103.

5. Patents \Rightarrow 16.25

Fact that many of the diphenols specifically enumerated in prior reference were derivatives of bisphenol A of which flash fusible toner of claim 1 for which applicant sought patent was comprised did not establish that reference suggested selection of bisphenol A itself in preparation of toner so as to render claim unpatentable on ground of obviousness, where, according to specification, diphenol in esters of claim could only be bisphenol A, and not bisphenol A derivative. 35 U.S.C.A. § 103.

6. Patents \Rightarrow 16.25

Disclosure of millions of compounds does not render obvious and unpatentable claim to three compounds, particularly when that disclosure indicates preference leading away from claimed compounds. 35 U.S.C.A. § 103.

John A. Brady, Lexmark Intern., Inc.,
Lexington, Kentucky, argued, for appellant.

Adriene B. Lepiane, Asst. Sol., Office of
the Sol., Arlington, VA, argued, for appellee.
With her on the brief were Fred E. McKel-
vey, Sol. and Richard E. Schafer, Associate
Sol.

Before MICHEL, PLAGER and
LOURIE, Circuit Judges.

LOURIE, Circuit Judge.

Applicants Brian W. Baird, Art F. Diaz, William H. Dickstein, and Charles M. Seymour (collectively Baird)¹ appeal from the October 15, 1992 decision of the U.S. Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences, Appeal No. 92-0860, affirming the examiner's final rejection of claims 1-5 of application Serial No. 07/333,524, entitled "Flash Fusible Toner Resins," as unpatentable on the ground of obviousness under 35 U.S.C. § 103 (1988). We reverse.

BACKGROUND

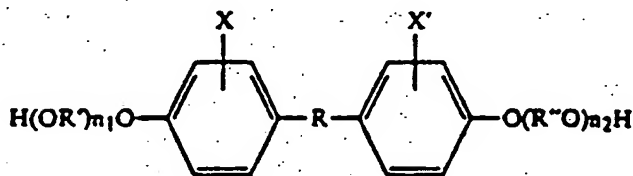
Baird's application is directed to a flash fusible toner comprising a polyester of bisphenol A and an aliphatic dicarboxylic acid. Synthesis of the toner compositions involves the acetylation of bisphenol A and the reaction of that product with an aliphatic dicar-

boxylic acid selected from the group consisting of succinic acid, glutaric acid, and adipic acid. The application discloses that toners containing bisphenol A have optimal characteristics for flash fusing including, *inter alia*, high thermal stability and low critical surface energy.

Claim 1, the only claim at issue, reads as follows:

1. A flash fusible toner comprising a binder resin which is a bisphenol A polyester containing an aliphatic di[carboxylic] acid selected from the group consisting of succinic acid, glutaric acid and adipic acid.

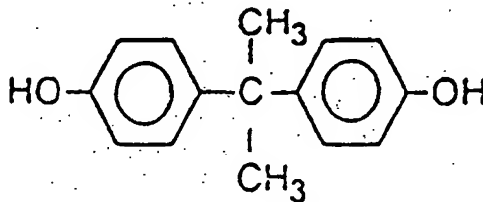
Claim 1 stands rejected as obvious over U.S. Patent 4,634,649 to Knapp et al., which relates to developer compositions comprised of, *inter alia*, the polymeric esterification product of a dicarboxylic acid and a diphenol of the following generic formula:



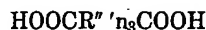
wherein R is selected from substituted and unsubstituted alkylene radicals having from about 2 to about 12 carbon atoms, alkylidene radicals having from 1 to 12 carbon atoms and cycloalkylidene radicals having from 3 to 12 carbons atoms; R' and R'' are selected from substituted and unsubstituted alkylene radicals having from 2 to 12 carbon atoms, alkylene arylene radicals having from 8 to 12 carbon atoms and

arylene radicals; X and X' are selected from hydrogen or an alkyl radical having from 1 to 4 carbon atoms; and each n is a number from 0 (zero) to 4.

Col. 4, lines 16-38. The Knapp formula contains a broad range of variables and thus encompasses a large number of different diphenols, one of which is bisphenol A, which is shown in Baird's application as having the following structure:



Knapp also discloses that the dicarboxylic acids have the general formula:



1. The real party in interest is Lexmark Interna-

tional, Inc.

wherein R'' is a substituted or unsubstituted alkylene radical having from 1 to 12 carbon atoms, arylene radicals or alkylene arylene radicals having from 10 to 12 carbon atoms and n_3 is a number of less than 2.

Col. 5, lines 6-14. Twenty typical dicarboxylic acids are recited, including succinic acid, glutaric acid, and adipic acid, the dicarboxylic acids recited in claim 1.

The examiner rejected claim 1 as obvious on the ground that Knapp specifically discloses as components of his esters the three dicarboxylic acids recited in claim 1 and a generic formula which encompasses bisphenol A. Recognizing that bisphenol A is defined when certain specific variables are chosen, the examiner reasoned that bisphenol A "may be easily derived from the generic formula of the diphenol in [Knapp] and all the motivation the worker of ordinary skill in the art needs to arrive at the particular polyester of the instant claim[] is to follow [that formula]."

The Board upheld the examiner's rejection. It rejected Baird's argument that there was no motivation for one to select bisphenol A from Knapp and summarily concluded that "the fact that [the claimed] binder resin is clearly encompassed by the generic disclosure of Knapp . . . provides ample motivation for the selection of [the claimed composition]." Slip op. at 3. The Board's decision was affirmed on reconsideration.

DISCUSSION

[1] The only issue before us is whether the record supports the Board's conclusion that, in view of the teachings of Knapp, the claimed compounds² would have been obvious to one of ordinary skill in the art. We review an obviousness determination by the Board *de novo*, while we review underlying factual findings for clear error. *In re Beattie*, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed.Cir.1992).

[2] Baird does not dispute the fact that the generic diphenol formula of Knapp en-

compasses bisphenol A. Nor does Baird dispute that Knapp specifically discloses the three dicarboxylic acids recited in claim 1. Rather, Baird argues that there is no suggestion in Knapp to select bisphenol A from the vast number of diphenols covered by the generic formula and that the Board thus erred in concluding that the claimed compounds would have been obvious.

[3, 4] What a reference teaches is a question of fact. *Beattie*, 974 F.2d at 1311, 24 USPQ2d at 1041. The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed.Cir.1992) (rejecting Commissioner's argument that "regardless [] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it"). *Jones* involved an obviousness rejection of a claim to a specific compound, the 2-(2'-aminoethoxy)ethanol salt of 2-methoxy-3,6-dichlorobenzoic acid (dicamba), as obvious in view of, *inter alia*, a prior art reference disclosing a genus which admittedly encompassed the claimed salt. We reversed the Board's rejection, reasoning that the prior art reference encompassed a "potentially infinite genus" of salts of dicamba and listed several such salts, but that it did not disclose or suggest the claimed salt. *Id.*

In the instant case, the generic diphenol formula disclosed in Knapp contains a large number of variables, and we estimate that it encompasses more than 100 million different diphenols, only one of which is bisphenol A. While the Knapp formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the disclosure of Knapp suggesting that one should select such variables. Indeed, Knapp appears to teach away from the selection of bisphenol A by focusing on more complex diphenols, including 2,2-bis(4-beta-hydroxyethoxyphenyl)propane, 2,2-bis(4-hydroxypropoxyphenyl)propane, and 2,2-bis(4-hydroxyisopropoxyphenyl)propane. Col. 4, lines 51-64. Knapp teaches that in preferred diphenols, R

and the PTO has premised its obviousness rejection on the obviousness of the compounds, we will treat this case accordingly.

2. Since the toner, the resin, and the polyester compounds appear to be treated in the Board opinion and patent application as synonymous,

has 2 to 4 carbon atoms and R' and R" have 3 to 4 carbon atoms, and in "optimum" diphenols, R is an isopropylidene radical, R' and R" are selected from the group consisting of propylene and butylene radicals, and n is one. Col. 4, lines 38-47. Knapp further states that the diphenol in the preferred polyester material is 2,2-bis(4-hydroxyisopropoxyphenyl)propane. Col. 5, lines 36-38. Fifteen typical diphenols are recited. None of them, or any of the other preferred phenols recited above, is or suggests bisphenol A.

[5] The Commissioner repeatedly emphasizes that many of the diphenols specifically enumerated in Knapp are derivatives of bisphenol A. He argues that Knapp thus suggests the selection of bisphenol A itself. We disagree, because, according to the specification, the diphenol in the esters of claim 1 can only be bisphenol A, not a bisphenol A derivative. While Knapp may suggest certain complex bisphenol A derivatives, it does not describe or suggest bisphenol A and therefore does not motivate the selection of bisphenol A.

[6] "[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests." *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979). Given the vast number of diphenols encompassed by the generic diphenol formula in Knapp, and the fact that the diphenols that Knapp specifically discloses to be "typical," "preferred," and "optimum" are different from and more complex than bisphenol A, we conclude that Knapp does not teach or fairly suggest the selection of bisphenol A. See *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed.Cir.1993) (DNA sequence would not have been obvious in view of prior art reference suggesting a nearly infinite number of possibilities and failing to suggest why among all those possibilities one would seek the claimed sequence). A disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.

CONCLUSION

The Board clearly erred in finding that Knapp would have provided the requisite motivation for the selection of bisphenol A in the preparation of the claimed compounds. Accordingly, the decision of the Board affirming the rejection of claim 1 as obvious over Knapp is reversed.

COSTS

No costs.

REVERSED



TRANSPAC DRILLING VENTURE, 1983-63 by CRESTWOOD HOSPITALS, INC., Transpac Drilling Venture, 1983-1 by Crestwood Hospitals, Inc., Transpac Drilling Venture, 1983-2 by James M. Dobbins, Transpac Drilling Venture, 1983-4 by Bryan D. Burr, Plaintiffs-Appellants,

and

Transpac Drilling Venture, 1983-14, by Alister Corporation, Transpac Drilling Venture, 1983-38 by Lindsey & Hall, Inc., Plaintiffs,

v.

UNITED STATES, Defendant-Appellee.

No. 93-5045.

United States Court of Appeals,
Federal Circuit.

Feb. 8, 1994.

Government moved to dismiss petitions for readjustment filed by partnerships. The United States Claims Court, Margolis, J., 26 Cl.Ct. 1245, dismissed petitions, and partnerships appealed. The Court of Appeals, Nies, Chief Judge, held that: (1) partners who became general partners for limited purpose